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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,163	04/11/2005	Olof Karlsson	05031	9353

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DENNISON, SCHULTZ & MACDONALD  
1727 KING STREET  
SUITE 105  
ALEXANDRIA, VA 22314

EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/527,163

Applicant(s)

KARLSSON, OLOF

Examiner

Stephen F. Gerrity

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/22/06</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Response to Preliminary Amendment**

1. Receipt is acknowledged of a preliminary amendment, filed 9 March 2005, which has been placed of record and entered in the file.

### **Information Disclosure Statement**

2. Receipt is acknowledged of an Information Disclosure Statement, filed 22 November 2006, which has been placed of record in the file. An initialed, signed and dated copy of the PTO-1449 form is attached to this Office action. Note, the crossed through reference on the attached form PTO-1449 is a duplicate entry.
3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### **Drawings**

4. The drawings are objected to because the figures 6a-6c must not be connected by lines, and they must be individually labeled as Figure 6a, Figure 6b and Figure 6c. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an

amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Specification**

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested that the title of the invention be amended so that it is consistent with the claimed and elected invention.
6. The abstract of the disclosure is objected to because the word “the” is misspelled in line 7. Correction is required. See MPEP § 608.01(b).
7. The disclosure is objected to because of the following informalities: the arrangement of the written description does not comply with 37 CFR 1.77(b).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

### **Arrangement of the Specification**

Art Unit: 3721

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

8. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. The current specification is replete with grammatical and idiomatic informalities, too numerous to mention specifically.

### **Claim Rejections - 35 USC § 112**

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**10.** Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In claim 1, expressions such as “where appropriate” (line 4) and “as an example” (lines 7 and 8) fail to particularly point out the invention and render the claim language vague and indefinite.

Claim 5 is considered to be vague and indefinite because the language “separated from each other in the longitudinal direction of the paper tube by embossing joints” renders the claim ambiguous. It is unclear from the claim as to when the envelopes are separated or in fact what is meant to be conveyed by the term “separated”.

Claim 6, the language of part a) renders the claim vague and indefinite because the language is awkwardly written and it is not understood as what is meant to be conveyed by the language “at wait state”.

Claim 6, the language of part b) concerning “a long, flattened paper tube” renders the claim vague and indefinite because it is unclear if the long paper tube recited in claim 5 is one and the same as the now recited “long, flattened paper tube”.

Claim 10, line 3, the recitation “the cutting operation” lacks proper antecedent basis.

These and any other informalities should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

### **Claim Rejections - 35 USC § 102**

**11.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**12.** Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Imbault (**GB 642,552**).

The Imbault reference clearly teaches a method in which an envelope is provided, which after inherently filling is closed by embossing - see fig. 1.

**13.** Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Klinger (**US 1,958,005**).

The Klinger reference clearly teaches a method in which an envelope is provided, which has either a flap or no flap, and which after inherently filling is closed by embossing - see figs. 8-11, and page 2, lines 79-145.

**14.** Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stemmler (**US 2003/0234282**).

Stemmle discloses providing an envelope (104) which may be formed and the envelope has an edge opened so that an object (enclosure 106) is inserted - para. 0031 - finally the open edge may be closed by embossing. Stemmle also discloses that the envelope may have a flap - 6A-6C - which is folded over prior to embossing the flap closed.

### **Claim Rejections - 35 USC § 103**

**15.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**16.** Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Imbault (**GB 642,552**), Klinger (**US 1,958,005**), or Stemmle (**US 2003/0234282**), in view of Sekine et al. (**US 5,454,601**).

Any one of the Imbault, Klinger, or Stemmle reference does not disclose that the second peripheral edge has a notch, but the Sekine et al. reference discloses that it is old and well known in the relevant art to provide a notch at a peripheral edge to aid in opening the envelope packet. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified any one of the Imbault, Klinger, or Stemmle method of filling an envelope by having provided a notch at the second peripheral edge, as taught by Sekine et al., for the purpose of aiding in the opening of the envelope.



**17.** Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klinger (**US 1,958,005**) in view of Schultz (**US 3,350,988**).

The Klinger reference discloses that after the envelopes are formed (see for instance figures 8 and 9) they are separated into individual envelopes by longitudinal and transverse cutting. Each individual envelope being separated by embossed edges and open at one end, with the embossing joints formed perpendicular (42) to the feed direction. The Klinger reference is considered to meet all of applicant's claimed subject matter with the exception of the envelope constitutes a part of a long paper tube with the envelopes being separated by embossing joints, and manufactured at the production of the envelopes. The Schultz reference discloses a method for making envelopes in which a long tube of finished, but unfilled, envelopes is made and the long tube of envelopes is wound onto a roll at the manufacturing location. The wound roll of envelopes can then be sent to an end user who unwinds the roll of envelopes and fills them as desired - see col. 6. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Klinger method of making and filling envelopes by instead of having the envelopes separated individually by longitudinal and transverse cutting, to have provided the envelopes as a long paper tube of envelopes which are separated from one another by the transverse embossment (42) and to have wound the envelopes on a roll at the manufacturing location for distribution to an end user, as suggested by Schultz, where they may be individually filled and closed by embossing, in order to produce large quantities of envelopes for being processed by an end user in an end users inserting machine.

**18.** Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 5 above, and further in view of Brockdorff (**GB 2,252,540**).

The Klinger method, as modified by Schultz above, meets all of applicant's claimed subject matter with the exception of supplying a number of consignments for mailing to different addresses and supplying the long flattened paper tube which paper tube has at least one open side. The Brockdorff reference discloses that it is old and well known in the relevant art to provide a long flattened paper tube (A) for filling along one opened side (at D) with a number of different consignments (disclosed as infinite in there variety of thickness and size (shape)) for different addresses which are filled through the open side of the long flattened paper tube. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Klinger method to have provided a number of different consignments for mailing to different addresses which are inserted into the long flattened paper tube through an open side of the tube, as suggested by Brockdorff, for forming the completed envelopes at a high speed and continuous basis.

Concerning claim 7, the Brockdorff reference teaches that because the inserts (consignments) will be provided to the open side of the tube with different sizes and shapes, that it is important to coordinate the location of glue patterns to the different sizes and shapes. This is considered as teaching that the tube is advanced a length corresponding to a dimension of the insert (consignment). It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Klinger method by having advanced the long paper tube by a

length corresponding to a dimension of the insert (consignment) as taught by Brockdorff, in order to accommodate inserts of various dimensions and lengths.

Concerning claim 8, the Brockdorff reference teaches that the inserts are inserted into the open side of the tube in a direction perpendicular to the direction of movement of the tube. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Klinger method by having inserted the inserts into the open side of the long paper tube in a direction perpendicular to the direction of movement of the paper tube, as taught by Brockdorff, in order to process the inserts at a high speed.

Concerning claims 9 and 10, the combination of Klinger, Schultz and Brockdorff, teaches that it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have closed the paper tube by embossing any open portions of the paper tube, in order to ensure the security of the contents of the envelope.

Concerning claim 11, the Klinger reference already teaches that the paper tube may be formed from two sheets which are joined together by embossing.

Concerning claim 12, the technique for forming the long paper tube is by the use of overlapping folding of a long sheet of paper which is glued in the folding in the Brockdorff method, and it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Klinger method by having used overlapping folding of the long paper sheet and gluing of the overlapped sheet in the folding, as such is similar old and well known technique of

forming an envelope, and substituting one technique for another is routine to one skilled in the art.

**19.** Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 5 above, and further in view of Noe (**US 2,580,456**).

The combination of Klinger and Schultz does not teach that the tube is formed by folding a long sheet and embossing the open long side of the tube. The Noe reference teaches a method for forming tubes in which a sheet is folded over and the longitudinal edges are joined together by embossing. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the Klinger method by having substituted the technique of forming the tube by having folded a long sheet and to have joined the longitudinal edges of the open side by embossing, as taught by Noe, as the substitution of one old and well known technique for forming a tube for another is routine to one of ordinary skill in the art.

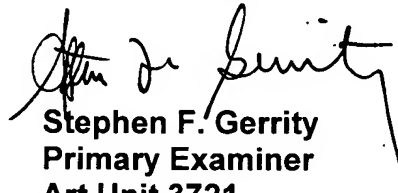
### **Conclusion**

**20.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show various methods and machines for forming and filling of envelopes and packages. All are cited as being of interest and to show the state of the prior art.

**21.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**Stephen F. Gerrity**  
**Primary Examiner**  
**Art Unit 3721**

26 March 2007